

REMARKS

Claims 1 to 24 stand rejected under 35 USC 101 on the ground that the claims "do not recite technology." Applicant respectfully disagrees.

In the two-part test offered by the Examiner, the issue of producing a "useful, concrete, tangible result" does not appear to be challenged. Indeed, it has been held that "adding billing data to telephone record is useful, non-abstract result," well-grounded in an area of the technological arts. AT&T Corp. v. Excel Communications Inc., 172 F.3d 1352 (Fed. Cir. 1999).

Rather, the Examiner contends that the invention does not utilize technology in a "non-trivial manner," citing *Ex parte Bowman*.¹ In *Bowman*, the Examiner asserted that the claimed invention did not fall within the technological arts because no form of technology was disclosed or claimed. The Appellant argued that, under the USPTO's Examination Guidelines for Computer-Related Inventions, creating a chart and plotting a point is "physical and has clear real world value." In particular, the claimed process resulted in a physical transformation outside of a computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan.

The Board agreed with the Examiner, noting that "Appellant has carefully avoided tying the disclosed and claimed invention to any technological art or environment." The Board reasoned that the invention was directed merely to a human making mental computation and manually plotting results on paper and thus is nothing more than an abstract idea which is not tied to any technological art or environment. According to the Board, an abstract idea does not become a technological art merely by the recitation of "transforming physical media into a chart" and "physically plotting a point on said chart."

This case is entirely different. First, Applicant's disclosure is rife with references to technological apparatus and implementations. See, for example, Figure 1 and accompanying test. Secondly, and perhaps more importantly, claims 1 and 10 (the only independent claims) positively recite a "communication link." Claim 1 includes the limitation of "providing the information via a communication link to a destination location within a close time proximity to the actual consumption of

¹ The Examiner's citation of *Bowman* is incorrect. It is 61 USPQ2d 1669 – not 1665.

the service,” and claim 10 includes the limitation of “forwarding, within a close time proximity to the consumption of the measured units of Internet service by one or more users, information via a communication link to a designated location, where the information includes at least one of the tally of the measured unit of Internet service, the assessed rated, and the calculated price.” Thus, the inventions of the instant application clearly recite “technology.” The invention in the body of the claim is clearly tied to technological art, environment, or machine.”

Claims 1 to 9 stand rejected under 35 USC §102 over McNamara et al., U.S. Patent No. 5,818,725. Claims 10 to 24 also stand rejected over McNamara et al., either alone or in combination. McNamara is directed to a system for electric power demand monitoring and control. The system includes one or more data distribution networks interconnecting network interfaces or intelligent utility units located at customer sites with a host computer located in the utility company offices. A network within the site interconnects each intelligent utility unit or network interface with power consuming units for providing data on power usage and power control. A data distribution network interconnects the plurality of intelligent utility units or network interfaces to the host computer as a head end unit, the data distribution network providing downstream communication channels from the host computer to the plurality of intelligent utility units and network interfaces, and upstream communication channels from the plurality of intelligent utility units and network interfaces to the host computer. The communication channels are organized as frequency division multiplex channels in a frequency spectrum. A plurality of distribution networks can be provided for a larger utility environment with each distribution network associated with a power substation and customers served by the power substation.

By this amendment, claim 1 has been modified to better define the invention by substituting “information received over a digital network” for the “the consumed service.” It is believed that, for reasons set forth hereinbelow, that independent claim 10 need not be amended.

With respect to rejection of claim 10, the Examiner concedes that McNamara does not explicitly disclose the Internet, but cites column 2, lines 60-67 of McNamara et al. for disclosing “a network the Internet as a network.” However, referring the passage cited by the Examiner, this is not the same network over which services are received by a consumer. Rather, according to the ’725 patent, it simply the central computer that uses a network for information exchanged, whereas it is a power network over which consumers receive electric power. This is entirely different from the information received by

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consumers according to the instant invention, which has to do with digital data and not electrical power.

Based upon the foregoing, Applicant believes all claims are in condition for allowance. To expedite prosecution, the undersigned attorney may be contacted by telephone, facsimile or electronic mail.

Respectfully submitted,

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